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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/941,605	09/30/97	WOOD E	ITI-138C

MICHAEL I WOLFSON  
COWAN LIEBOWITZ & LATMAN  
1133 AVENUE OF THE AMERICAS  
NEW YORK NY 10036

IM71/0514

EXAMINER

HAYES, J

ART UNIT

1772

PAPER NUMBER

DATE MAILED:

05/14/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/941,605

Applicant(s)

Wood

Examiner

Jennifer Hayes

Group Art Unit

1772



☒ Responsive to communication(s) filed on Sep 30, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 9 and 10 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 9 and 10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Information Disclosure Statement*

1. Receipt is acknowledged of Applicant's Information Disclosure Statement and references. If the citation is in conformance with MPEP 609 the citation was considered and initialed by the Examiner. If the citation is not in conformance with MPEP 609, the citation was not considered by the Examiner and a line was drawn through the citation. A copy of the PTO-1449 form, completed by the Examiner, is attached to this Office Action.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 9 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Endoh (US 5,329,063). Endoh teaches a flexible tubular resin absorbent liner which is impregnated with a curable resin, having a collar formed on one end which conforms to the inner wall of the main pipe which forms the brink of the opening of the branch pipe. (Col. 5, lines 12-21).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endoh as applied above. Endoh does not specifically teach the liner including further reinforcement at the junction between the tubular fibrous material and the collar. However tubular reinforcement materials are well known to those of ordinary skill in the art. Additionally, Endoh does teach a detachable tube consisting of a reinforcement material covering the external wall of the liner except in the area of the collar. It would have been obvious to one of ordinary skill in the art to use conventional techniques and incorporate reinforcing materials into the liner to alleviate the need for the detachable tube taught by Endoh.

***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 9 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,692,543. Although the conflicting claims are not identical, they are not patentably distinct from each other because the tubular lining of the present application is an obvious variation of the tubular lining claimed in the above mentioned patent without the preformed sealing collar..

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer M. Hayes whose telephone number is (703) 308-9545.

  
ELLIS P. ROBINSON  
SUPERVISORY PATENT EXAMINER  
1772

jmh

May 8, 1998